

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks and accompanying information, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-3, 5, 7, 11, 13, 15, 17, 19, 20, 22, 23, 25, 26, 28-32, 34-41, 101, and 104-107 are pending in this application. Claims 1, 2, 40, and 41 are amended without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

Support for the amendment to the claims can be found throughout the specification as originally filed. For example, support for the amendment to recite “means for introducing into said chamber from an input storage container a cell population including committed cells” can be found, for instance, on page 10, lines 20-23, and on page 22, lines 27-31. Support for the amendment to recite “means for removing from the chamber into an output storage container a sample of cells comprising undifferentiated cells” can be found, for example, on page 10, lines 20-23, and on page 25, lines 17-23. Further, support for the amendment to recite “wherein the chamber, the input storage container, and the output storage container are disposable” can be found, for instance, on page 10, lines 20-23, and on page 23, lines 25-26. No new matter is added.

It is submitted that the claims herewith are patentably distinct over the prior art, and these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims presented herein are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply to clarify the scope of protection to which Applicant is entitled.

II. THE ART REJECTIONS ARE OVERCOME

Initially, Applicant respectfully notes that “[a] rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” *In re Buszard* 504 F.3d 1364, 1366 (Fed. Cir. 2007) (citing *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383

(Fed. Cir. 2001) (“Invalidity on the ground of ‘anticipation’ requires lack of novelty of the invention as claimed . . . that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim.”)).

Regarding rejections under Section 103, Applicant respectfully reminds that the Supreme Court has recently reaffirmed the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: “[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are . . . ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727. Furthermore, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggests the desirability of the modification.” Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicant’s disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Gilford, and Gilford in view of North

Claims 1-3, 7, 17, 19, 20, 22, 23, 25, 26, 28, 29-32, and 34-41 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Gilford (U.S. Patent No. 4,058,367). Claims 1-3, 5, 7, 17, 19, 20, 22, 23, 25, 26, 28, 29-32, and 34-41 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gilford in view of North (U.S. Patent Publication No. 2001/0052763). These rejections are traversed and will be addressed collectively.

Firstly, Applicant asserts that Gilford does not anticipate the claimed invention. Applicant refers to the instant claims, which herein clarify that the means for introducing a cell population into the chamber is from an input storage container; that the device also comprises a means for removing from the chamber into an output storage container a sample of cells comprising undifferentiated cells; and that the chamber, the input storage container, and the output storage container are disposable.

In contrast, Guilford relates to a device comprising a guideway and a carriage that moves a sample container through multiple zones (Guilford, col.4, ll.59-64). The Examiner seems to be equating the chamber of the present invention with the container in Guilford (Office Action at 3), however, the sample containers from Guilford are extracted from a supply to enter into a reading zone (*see*, Guilford, col.4, l.64 – col.5, l.7), and there is no teaching or even suggestion in Guilford of a means for introducing a cell population into the sample container from an input storage container. Moreover, in the last zone of the device in Guilford, the sample container may be moved off of the carriage into a discard apparatus (Guilford, col.11, ll.27-34), and there is no teaching or even suggestion of a means for removing a sample of cells comprising undifferentiated cells from the container into an output storage container. Hence, Guilford fails to teach each and every element of the instant claims. Notably, North, which relates to an orifice arrangement for electrical resistance pulse sizing of particles suspended in an electrically conducting fluid, does not remedy the deficiencies in Guilford.

In addition, one of ordinary skill in the art would not arrive at the claimed invention based on the disclosure in Guilford and/or North. There is no teaching in either reference of a means to introduce or remove cells to the container of Guilford, and there is motivation or predictability of success associated with modifying Guilford and/or North to arrive at the claimed invention.

Thus, Guilford, or the combination of Guilford and North, does not anticipate or render the claimed invention unpatentable. Accordingly, Applicant requests reconsideration and withdrawal of the rejections under Sections 102 and 103.

Tomioka et al., and Tomioka et al. in view of Johnson

Claims 1-3, 7, 17, 19, 20, 22, 23, 25, 26, 28-32, and 34-41 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Tomioka et al. (U.S. Patent No. 4,983,359). Claims 1-3, 7, 11, 13, 17, 19, 20, 22, 23, 25, 26, 28-32, and 34-41 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tomioka *et al.* in view of Johnson (U.S. Patent No. 4,563,907). These rejections are traversed and will be addressed collectively.

Applicant asserts that Tomioka et al. does not anticipate the claimed invention. Applicant reiterates that the instant claims herein clarify that the means for introducing a cell population into the chamber is from an input storage container; that the device also comprises a means for removing from the chamber into an output storage container a sample of cells

comprising undifferentiated cells; and that the chamber, the input storage container, and the output storage container are disposable. On the other hand, Tomioka et al. relates to a device comprising an incubator having different sections to which a pipette discharges and removes cell samples, agents, etc. *See, generally*, Tomioka et al., col.4, ll.4-60. The Examiner seems to be equating the chamber of the present invention with the incubator in Tomioka et al. (Office Action at 3), however, the incubator from Tomioka et al. is not disposable, as it is used to house the cell samples as it rotates through the different stages. *See id.* Therefore, there is no teaching or suggestion in Tomioka et al. of a chamber that is disposable, and thereby Tomioka et al. fails to teach each and every element of the instant claims. Notably, Johnson, which relates to an apparatus for dispensing and/or diluting metered amounts of fluid, does not remedy the deficiencies in Tomioka et al.

In addition, one of ordinary skill in the art would not arrive at the claimed invention based on the disclosure in Tomioka et al. and/or Johnson. There is no teaching in either reference of a disposable chamber, and there is motivation or predictability of success associated with modifying Tomioka et al. and/or Johnson to arrive at the claimed invention.

Thus, Tomioka et al., or the combination of Tomioka et al. and Johnson, does not anticipate or render the claimed invention unpatentable. Accordingly, Applicant requests reconsideration and withdrawal of the rejections under Sections 102 and 103.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested and the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

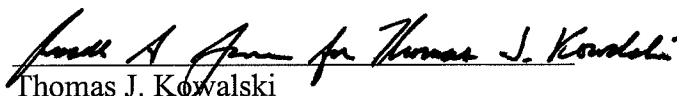
CONCLUSION

In view of the remarks and amendments herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,

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